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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,999	04/12/2004	Christof Behmenburg	203-032	1581

7590 04/08/2005

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EXAMINER

BUTLER, DOUGLAS C

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,999

Applicant(s)

BEHMENBURG ET AL.

Examiner

Douglas C. Butler

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-10 are pending.
2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. The EPO Search Report and prior art included therein has been considered and made of record. EP 1467117 A2 and EP 1467117 A3 are ^{also} made of record. Schultz (003) has been crossed through since it was previously made of record by the examiner. The EPO Search Report was not available in IFW at the time of the last office action.
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over submitted FR 2728948 or Behmenburg et al (US 2003/0173723 A1) or submitted

Watanabe et al (145) or Schultz (3046003) in view of submitted DE 19642024 to Joseph or Crabtree et al. (5752692), all of record, or newly cited Harris (5129634).

Each of the primary references discloses the invention substantially as claimed except for the feature relating to eccentric arrangement of the chambers. The feature of "countering transverse forces on the strut" is not recited in the claims.

See Figs. 1-3 of FR 2728948, Figs. 1-6 of Behmenburg et al (723), Fig. 9 of submitted Watanabe et al (145) and Figs. 1-2 of Schultz (003).

It would have been obvious at the time the invention was made to one having ordinary skill in the art to which the invention pertains to eccentrically arrange the chambers of each of the primary references as taught references to Joseph (submitted DE 19642024) or Harris (634) or Crabtree et al (692) in order to accommodate transverse forces on the respective strut and/or for equalizing "an axial length of the rolling lobe for durability", as advanced by applicants.

See column 1, lines 18-25 of newly cited Harris (634) which states:

"Methods known for creating horizontal acting side load in a vehicle suspension strut incorporating a hydraulic shock absorber and an airspring include utilizing an airspring piston **eccentrically** mounted on the shock absorber to create a non-symmetric **rolling lobe** in the flexible member of the airspring. Another alternative approach is to mount the airspring offset and at an angle to the shock absorber rod."

6. Applicants state on page 7 of the Remarks section of the response filed Jan. 10, 2005 that the instant invention differs from the prior art in that in the instant invention "the eccentric arrangement of the air chambers to each other of the applicants' invention

Art Unit: 3683

will allow compensation for both transverse forces at the air spring and the claim 1 requires:

“said inner air chamber and said outer air chamber being arranged eccentrically to each other.” (emphasis added).

Applicants also state that in “contrast, the eccentric arrangement of the air chambers to each other of the applicants’ invention will allow compensation for both transverse forces at the air spring and the traverse forces that result from damping [Examiner’s emphasis]. In fact, small eccentricities will allow compensation for relative high transverse forces of both types. The outer air chamber causes a small force upwards and the inner air chamber causes a greater force downwards creating a resulting force downwards. In view of the eccentric arrangement of the air chambers to each other, the line of effect of the resulting force can, in contrast to Crabtree and Joseph, be directed to the desired to the desired compensation point so that not only transverse forces at the air spring, but also transverse forces that result from damping, can be directed through the compensation point (this effect is enhanced by a higher inner pressure in the air chambers)...”

The claims do not recite the feature directed to allowing for both transverse forces at the air spring and the transverse forces that result from damping. It appears that claim 1 should be amended to include the features directed to transverse forces since the claims are broader than the arguments being made in support of patentability. See page 2 of the specification where applicants state that it “is from this point that the invention proceeds”. In the examiner’s view and based upon applicants’ remarks,

Art Unit: 3683

claims specific to the departure from the prior art would be directed to patentable subject matter; i.e., the examiner is in substantial agreement with applicants provided the dual advantage is claimed.

7. To provide applicants with a full and fair hearing on the issues dealing with patentability, this action is not been made final to extend another opportunity for applicants to patentably define the invention consistent with applicants' arguments.

8. Any inquiry concerning this communication should be directed to Exmr Butler at telephone number 703-308-2575.

 3/23/05
DOUGLAS C. BUTLER
PRIMARY EXAMINER
AU 3683

Butler/vs
March 23, 2005